

REMARKS

It is noted with appreciation that the Examiner has withdrawn the rejection under 35 USC § 112.

Obviousness Rejection

Claims 1-19 were finally rejected under 35 USC §103(a) as being unpatentable over Cain et al. (EP 0 901 804) ("Cain") in view of Kimura (CAPLUS abstract, 1994:321866) ("Kimura"), Hohnen Oil CO. (CAPLUS abstract, AN 1986:18914) ("Hohen"), and Tanaka (CAOLUS abstract, AN 1989:153130) ("Tanaka"). (2/22/02 Office Action at 2.)

For the reasons set forth below the rejection, respectfully is traversed.

Cain discloses a fat dispersion requiring at least one fat, a particulated sweetener, and a viscosity reducing component. (p. 2, lns 17-18.) The fat was disclosed as being cocoa butter or fractions thereof, illipe or fractions thereof, palm oil fractions, palm kernel oil or fractions thereof, polyol poly esters and saturated triglycerides with fatty acid residues with mixed chain length, in particular having 2-12 and 16-24 C-atoms. (p. 3, lns. 6-8.) The sweetener was disclosed as being selected from glucose, fructose, sucrose, maltose, lactose, sorbitol, lactitol, mannitol, maltitol, xylitol, maltodextrin and polydextrose. (p. 2, lns. 56-58.) The viscosity-reducing component was disclosed as being a long chain alcohol having from 24-34 C-atoms. (p. 2, lns. 26, 34-54.) The Examples disclose preparing various chocolate formulations. In preparing the various formulations, the chocolate was melted, liquid cocoa butter was then added, and depending on the formulation, octacosanol was added. (Example I.) Example I disclosed that, all other ingredients being equal, octacosanol lowered the viscosity at 50°C from 0.33 Pas (no octacosanol) to 0.28 Pas (0.4% octacosanol). Example II disclosed that, without the cocoa butter, 0.4% octacosanol decreased the viscosity from 0.46 Pas (no cocoa butter, no octacosanol) to 0.33 (no cocoa butter, 0.4% octacosanol) at 50°C. Example III disclosed that hardened oil fractions did not decrease the viscosity at 50°C. Example IV disclosed the effect of adding the long chain alcohol as a solid and, among other things, the addition of an emulsifier, lecithin, to the formulation. This produced viscosities of 0.2025 Pas and 0.1956 Pas at 70°C. Example IV disclosed the effect of different sources of long chain alcohols.

Kimura discloses preparing a test liquid for administering intragastrically to mice having C 22-38 aliphatic alcohols, tocopherol (I), octacosanol (II) and corn oil. (Abst.) The results

demonstrated that octacosanol distributed higher in every tissue and organ than a test liquid having polyoxyethylene sorbitan monooleate instead of tocopherol and corn oil.

Hohmen discloses dissolving vitamin E, soybean lecithin, and octacosanol in vegetable oil. The dissolved solution was then encapsulated.

Tanaka discloses preparing an emulsified beverage by solubilizing octacosanol by fats and oils, water-soluble emulsifiers, and oil soluble emulsifiers, then mixing with aqueous solutions.

In making the rejection, the Examiner relied on the following reasoning set forth “in the prior office action.” (2/22/02 Office Action at 2.) In particular, the Examiner asserted that “Cain teaches a fat-containing product and the method of making the same.” (Paper No. 6 at 3.) The Examiner asserted that Cain’s mixture had reduced viscosity. The Examiner acknowledged, however, that Cain “does not expressly teach the employment of the particular vegetable oil or the particular food products herein, such as non-continuous oil phase products. (Paper No. 6 at 4.)

To fill the acknowledged gap, the Examiner relied upon Hohmen and Kimura as “teaching the employment of vegetable oil, such as soybean oil and corn oil for solubilization of fatty alcohols.” The Examiner also relied on Tanaka as “teaching employing oil-fatty alcohol mixture for making oil in water emulsion (non-continuous oil phase).” (Paper No. 10 at 3.)

The Examiner reasoned that:

(1) “[a] person of ordinary skill in the art would have been motivated to make an oil-long chain alcohol mixture wherein the oil is essentially free of medium chain triglyceride, or make the mixture into a non-continuous oil phase mixture because the long chain alcohol is known to reduce viscosity of oils, including those without medium chain glyceride;” (Paper No. 10 at 4);

(2) “[u]sing the alcohol-oil mixture taught by Cain to make a particular non-continuous oil phase food product is considered within the skill of the artisan, because it is known to employ oil-fatty alcohol mixture for making oil-in-water emulsion;”

(3) “optimization of the mixing procedure herein, is considered within the skill of the artisan;”

(4) “Cain’s claimed subject matter does not require any emulsifier or surfactant;”

(5) “Cain teaches the employment of long chain alcohol for reducing the viscosity of edible oil products;” and

(6) “[t]he difference claimed herein is in degree, not kind. Such variation is obvious and is well within the skill of the artisan.”

The Examiner concluded that “[I]t would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make an oil-long chain alcohol mixture wherein the oil is essentially free of medium chain triglyceride, or make the mixture into non-continuous oil phase mixture.” (Paper No. 10 at 3.)

In response to the paper submitted on December 18, 2001 by the undersigned, the Examiner took the position that, *inter alia*, “the primary reference [sic] teaches that the employment of long change fatty alcohol would reduce the viscosity of fat-containing food product.” (2/22/02 Office Action at 3.) The Examiner further appeared to take notice that “soybean oil is a well-known edible oil.” Additionally, the Examiner contended that “the second reference further teaches that the particular long chain alcohol employed herein, octacosanol, are known to be employed with vegetable oil for health benefit.” The Examiner reasoned that “[t]he motivation to employ long chain alcohol in any-fat containing food product, including soybean oil and/or those defined herein, is very clear to one of ordinary skill in the art: a) reduce the viscosity of the food product, and b) provide health food.” The Examiner further asserted that “[t]he benefit of reducing the viscosity of food product should be well understood by one of ordinary skill in the art” citing Cain.

The Examiner also asserted that the viscosity differences were one degree, not in kind.

The Examiner is reminded that a *prima facie* case of obviousness analysis of the subject matter **as a whole**. It is respectfully submitted that the Examiner failed to analyze the claim as a whole in rendering the rejection set forth above. In particular, the Examiner continued to rely on Tanaka for “teach[ing] that it is known to employ oil-fatty alcohol mixture for making oil in water emulsion (non-continuous oil phase).” However such reliance by the Examiner is evidence that the Examiner has not properly interpreted the pending claims.

Properly interpreted, the pending claims affirmatively require, *inter alia*, that the resulting high molecular weight alcohol/edible oil admixture be **free of an emulsifier**. Tanaka affirmatively discloses the use of an emulsifier.

As stated in the December 18, 2001 Response:

“Additionally, the emulsifier in Tanaka cannot be removed when combined with Cain because Tanaka is expressly concerned with “emulsified beverages.” One of ordinary skill

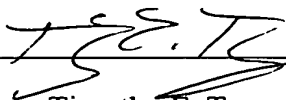
in the art, it is submitted, would know that such beverages affirmatively require emulsifiers. Thus, the combination of Tanaka with Cain would affirmatively require emulsifiers, which is expressly excluded from the claimed invention. Therefore, the rejection, to the extent it relies on Tanaka, is improper and should be withdrawn."

In fact, Tanaka affirmatively discloses, inter alia, using water soluble emulsifiers and oil soluble emulsifiers. Therefore, it is submitted, the rejection set forth by the Examiner must fail because the combination of documents relied on by the Examiner affirmatively require the use of an emulsifier. The Examiner has not cited any motivation or suggestion why one of ordinary skill in the art, based on the disclosure of the documents relied on, would not use an emulsifier. Absent such a suggest, the rejection is improper as a matter of fact and of law and should be withdrawn.

The December 18, 2001 Response is incorporated herein by reference. The reasoning set forth therein is equally applicable in view of the 2/22/02 Final Office Action. For these additional reasons, the rejection is improper and should be withdrawn.

Accordingly, for the reasons set forth above, withdrawal of the rejections and objections and allowance of the claims is respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

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